

1 RECORD OF ORAL HEARING

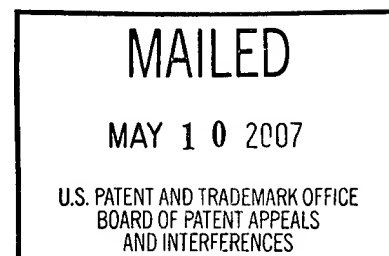
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3 UNITED STATES PATENT AND TRADEMARK OFFICE

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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
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10 Ex parte EUGENE J. ROLLINS, SAILENDRA PADALA,
11 NORBERT HENDRIKSE, PAUL GAUTHIER, and
12 MICHAEL TSO
13

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15 Appeal 2007-0791
16 Application 09/747,666
17 Technology Center 3600
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20 Oral Hearing Held: April 3, 2007
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24 Before MURRIEL CRAWFORD, TERRY OWENS, and ROBERT NAPPI
25 Administrative Patent Judges
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28 ON BEHALF OF THE APPELLANT:
29

30 RICK A. TOERING, ESQUIRE
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35 The above-entitled matter came to be heard on April 3, 2007,
36 commencing at approximately 10:05 a.m., at the United States Patent and

1 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Elizabeth
2 J. Walker, Reporter.
3

4 MR. TOERING: Good morning, Your Honors. This is
5 Application Serial No. 09/747,666, Rollins, et al., the
6 application entitled: "Tracking Transactions by Using
7 Addresses in a Communications Network." And my name is
8 Rick Toering, for appellants.

9 The status of the claims: 1 to 10, 18 to 27,
10 35 to 37 are pending in this case. All but Claims 2 and 19
11 are rejected under Section 102(e), as allegedly anticipated
12 by U.S. Patent No. 6029141 to Bezos. Claims 2 and 19 stand
13 rejected under Section 103, as allegedly unpatentable
14 over Bezos, in view of U.S. Patent No. 6532492 to
15 Presler-Marshall.

16 The appellants are appealing all the claims today,
17 though, for purposes of today's oral argument, I would like
18 to focus on claims 36, Claim 18, and follow-up with Claim 2.
19 Though we would preserve all argument with regards to the
20 other claims available to us, I just want to try and focus
21 the issues with you today.

1 I would just like to talk about a brief history
2 about the invention and the nature of the invention, how it
3 came to be, to give some background as to the prior art and the
4 claims.

5 Back in late '90s, shopping portals were a big
6 thing, or these instances of websites referring users to
7 other websites -- to merchants, for example. The issue was
8 that a user would be viewing one website, and there would be
9 a link on that page referring the user to some e-commerce
10 website, where they could purchase a particular item.

11 And Amazon had this system where they were
12 developing associate websites, and they had this associate
13 program. And if you had a website about skiing, you could
14 link to books about skiing that were, then, handled by
15 Amazon, and Amazon would be glad to sell you a book,
16 you know, when you clicked through that link.

17 So we have this notion occurring at this time with
18 intermediary websites, or associate websites, or portal
19 websites -- whatever you want to call them -- but they are
20 generally just -- they, themselves, are not selling the
21 goods. There is a merchant website behind them that is
22 selling the goods.

1 So, in the language of our claims we use the word
2 "intermediary." In the language of the prior art, they talk
3 about "associates" -- "associate web pages." I want to make sure that
4 you understand that those are sort of the same things; that the
5 merchant website is what is behind some of the other links.

6 So what was happening is that, if you were an
7 associate or an intermediate website, you would like to get a
8 commission when a user clicked through your site to the
9 Amazon, or the merchant, on the back side and actually bought
10 a book. So how were they going to track this in the system?

11 One of the things that -- the merchants were using
12 this to encourage these associate websites or these portal
13 websites to actually carry their links to their products.
14 So, when we look at it, the Bezos reference is exactly that
15 -- it is discussing one of the early implementations of this
16 system. They developed this notion called a referral link,
17 and this is described in the Bezos reference.

18 A referral link includes a tag that identifies
19 the intermediary website from which the user clicked to the
20 merchant website to purchase the product. Okay. Does that
21 make sense?

22 We have the link to the merchant website, and we

are tagging on this identifier, essentially, to that link, so that when its merchant receives that link and renders that page, the merchant sees this identifier, saying, "Oh, this user just came to me from the intermediary website. So if the user goes through a transaction and buys a book, I need to pay that intermediary a referral fee, or commission, or whatever it is."

So Bezos -- the reference that we have in front of us -- is this teaching of this referral link, which is, again, the link to the merchant webpage and an identifier that tags the referral source for the purposes of the merchant being able to identify from whence that click-through came.

JUDGE OWENS: Does that differ from your combined address, or does that fall outside the scope of your combined address?

MR. TOERING: No. That is combined address, okay?
That is our combined address in the scope of our claims.

All right. So now what is happening? This is an early implementation -- the Bezos reference. What is happening is that everybody is tagging these click-throughs. Everybody who has a link -- every intermediary portal is tagging these click-throughs, so that they can get some referral.

1 The links become very large. If you look in
2 the Bezos reference, all the links show up very nicely on
3 one URL listing in the teachings. But what happens is that
4 these URLs become very large. Well, at some point in time,
5 there is a limit on the size of a URL, and that limit is,
6 generally, 256 characters. If your URL becomes greater than
7 256 characters, you lose some of the information. It gets
8 truncated, or the Internet doesn't know how to process that
9 link, or whatever.

10 So our invention, then, is: What do we do when
11 these URLs get too big? We are not trying to claim the
12 referral links of Bezos. We are trying to claim: What
13 happens when those referral links get too big? What do
14 you do? Okay?

15 Our system is to take known portions of those
16 referral links and generate shortened identifiers -- what we
17 call, in the claim language, address identifiers. So you're
18 taking a big chunk characters in that URL and replacing it
19 with one more or more address identifiers.

20 For example, what we talk about in our spec, we
21 talk about a product may have -- a product available for a
22 merchant's website may have a very long link. You really

1 only need to know the link to the merchant, and you could
2 identify a shorthand nomenclature for the actual end piece of
3 that link to the particular product.

4 You know, for a company like L.L. Bean, or
5 something, they may have thousands of products, and you could
6 just shirt-size something or another. You could reduce that
7 down to something with some tables, et cetera, to reduce that
8 that link. All right? So that is our address identifiers.

9 Those are the shortening mechanisms by which we try and
10 reduce the size of the URL down to a manageable URL.

11 And that is, in essence, what we are doing. And
12 that is, in essence, what we are trying to claim. We are
13 trying to claim a combined address -- the referral link of
14 Bezos. We acknowledge that those are similar devices. But
15 when you get that combined address, you have to make a
16 check. And our claim language of Claim 36, for example,
17 is determining whether the combined address satisfies a
18 particular condition, one of those conditions being -- or
19 potentially being, in various embodiments -- the size of that
20 URL address.

21 And there is a difference between Claim 36
22 and Claim 18, but Claim 18 talks about when this condition

1 is not met -- when the size is not less than a preexisting
2 condition, the allowed size of the URL -- then we are
3 going to make some adjustments, and Claim 18 talks about
4 those adjustments.

5 The difference between Claim 18 and Claim 36
6 is we took out this "when" language that we were having
7 particularly difficulty with the examiner to acknowledge.
8 So Claim 18 has the "when" language. Claim 36 doesn't have
9 the "when" language. It just specifies the steps that
10 are performed.

11 Okay. So that, in essence, is what we are
12 claiming. If you have a combined address, it's too big, make
13 it smaller by generating this modified address. And the
14 modified address included these address identifiers. That
15 gets passed on to the merchant website.

16 So how does that different from Bezos? Well, we
17 have talked a little bit about how it would be different from
18 Bezos. We have talked about Bezos introduced this concept of
19 a referral link, which includes the merchant's website, plus
20 this tag. But Bezos is completely and entirely silent with
21 regards to any checks that are performed on that referral
22 link. There is no discussion in this reference about

1 checking a referral link against any condition.

2 JUDGE OWENS: Well, that isn't the condition the
3 examiner is relying upon, though.

4 MR. TOERING: No, it's not. And I'm getting
5 there. I'm sorry.

6 These referral links are hard-coded. That was one
7 of the problems of Bezos -- they were hard-coded. If you
8 read the Bezos reference, it talks about the referral links
9 being hard-coded in the associates' page. Any time those
10 things changes, they had to go back through an modify all
11 those merchant links to encode their tags.

12 So what happened in the system is, as technology
13 progressed, the intermediate websites were generating these
14 tags automatically. They were just slapping the tags on.
15 And that is when we started recognizing the problem that
16 overall links were becoming too large.

17 All right. So we have talked about what the claim
18 language is. We have talked about the difference that we are
19 talking about -- that Bezos doesn't talk about, doesn't
20 address these conditions.

21 And now to your point. The examiner is talking
22 about -- throughout the prosecution, he has only referred

1 to the figures in his rejections. It was not until the
2 examiner's answer that we have an articulated rejection --
3 you know, where his thinking is coming from.

4 And his thinking is that the reference teaches
5 the claims, based on some figures, and he points to a
6 couple figures in particular. He is looking at Figure 6
7 and Figure 8 of the Bezos reference.

8 I look at Figure 6 of the Bezos reference, and I
9 see a skiing website with a link down here to the bottom that
10 allows you to purchase a book. Okay? This figure itself
11 doesn't talk about any conditions that are applied to this
12 link or to the webpage.

13 And, very similarly, Figure 10 is another type of
14 website -- Figure 10-A, as we look at it, is another type of
15 website that, again, talks about an intermediary website with
16 links back to a merchant. But, again, there is no check
17 being performed on those links.

18 JUDGE OWENS: Well, the condition relied upon by
19 the examiner is the ability to buy a book. It says you can't
20 do it on this site, so it doesn't satisfy that condition.

21 MR. TOERING: So the condition is whether a user
22 should buy the book.

1 JUDGE OWENS: Can buy the book.

2 MR. TOERING: Right, whether a user can buy a
3 book. Is that a condition of the combined address, or is
4 that a condition of the content displayed to a user at the
5 combined address?

6 JUDGE OWENS: One of the advantages of being on
7 this side of the bench is we get to ask the questions.

8 MR. TOERING: It was a rhetorical question. But
9 that exactly goes to my point -- which is the examiner's
10 rejection is based on an interpretation of this reference
11 that goes to the user interpreting whether or not he wants to
12 buy a book. That is the condition. That is the condition
13 attributed to the content of the webpage, not a condition
14 against which a combined address is measured. Okay?

15 We are looking at the combined address -- at the
16 intermediary. We are not looking at the content. We are
17 not evaluating the content. We are not determining any
18 conditions of that content. So the examiner's reading in of
19 that saying, "Can the user buy this book?" has no bearing on
20 the relationship to the combined address.

21 And, furthermore, when you walk through the
22 examiner's logic on this, this is the address -- this page,

1 Figure 6, this content -- this is the content available at
2 the intermediary address. This is not content available at
3 the combined address. The combined address is this little
4 link down here on the bottom of the page.

5 So the examiner's attempt to say, "I'm determining
6 whether a user can buy a book here" -- a condition -- is not
7 being perform at the combined address. It is being performed
8 at the intermediary address.

9 And this is difficult because it is a very tortured
10 interpretation of the reference. It's hard for me to dispel
11 that logic because it doesn't make sense. This is the
12 combined address down here at the -- down here is the
13 combined address, the referral link to the merchant. When
14 you click on that, that is the link that we are evaluating.
15 But the examiner is saying that the condition has to occur at
16 the intermediary address. That is not applicable.

17 So even if you buy the ability of the examiner to
18 evaluate content at an address for purposes of determining a
19 condition, his construction is flawed because that condition
20 is occurring at the intermediary address and not the combined
21 address. When he selects the combined address, that's when
22 you go to the merchant page, and there is no more conditions
23

1 being evaluated at that point in time, based on the rejection
2 of the examiner.

3 So just to kind of elaborate on this -- or just to
4 kind of summarize it up a little bit, our claims are not so
5 broad as to permit this interpretation. Our claims talk
6 about determining whether the combined address satisfies a
7 particular condition. And the combined address is defined
8 in the claim as a combined address that identifies both an
9 intermediary address associated with the intermediary and an
10 object address that is determined based on the request.

11 These are the two things that are combined into
12 a referral link. We are going to evaluate that referral
13 link, and we are going to see if it meets a particular
14 condition, and then we are going to go process it by reducing
15 it, if necessary.

16 So, again, a fair reading of Bezos does not support
17 the examiner's rejection.

18 I want to draw the distinction between Claim 36 and
19 Claim 18 alluded to little bit earlier. We had kind of a
20 back-and-forth with the examiner on this conditional language
21 "when," specifying when certain steps were to be performed.

22 It was particularly frustrating, and I'm not
23

1 sure where that -- you know, it appears from the examiner's
2 answer that he has withdrawn that particular aspect of his
3 rejection. I don't know what more to say with that, other
4 than we have asked him about it multiple times, and we still
5 don't have a resolution, other than the answer. And we will
6 take it as that is sufficiently on the record to say that
7 that portion of the rejection is no longer there.

8 JUDGE OWENS: The examiner is relying upon the
9 address at column 5, lines 45 to 55 of Bezos as being the
10 combined address.

11 MR. TOERING: Line 5 --

12 JUDGE OWENS: Column 5, lines 45 to 55.

13 MR. TOERING: Right. That is the definition of
14 what a URL is.

15 JUDGE OWENS: Right. And that is what the examiner
16 relies upon here as the combined address.

17 MR. TOERING: But that's not a combined address.
18 That is just any arbitrary URL address. If you look on
19 page 7 of the examiner's answer, the last four or five lines
20 of that, it says, "Specifically, when the user starts out,
21 the user is at an associate website, which is defined by a
22 combined address." And he provides the URL. So he is
23

1 saying that the user's associate website is defined by a
2 combined address.

3 "When a user wants to order the book, the user
4 clicks on the hyperlink, which takes the user from the
5 intermediary website to a merchant website, thus substituting
6 a portion or perhaps all of the intermediary's URL with the
7 merchant's, thereby creating a modified combined address."

8 This is not a modified combined address. This is
9 the referral link of Bezos.

10 JUDGE OWENS: It is "the" combined address.

11 MR. TOERING: It is "the" combined address. There
12 is no modification. It's not fair to say that this is a
13 modification of address. This is a complete substitution.
14 That link is embedded in the webpage of Bezos.

15 JUDGE OWENS: Well, the problem the examiner
16 had was your claim says, "substituting at least a portion
17 of the address," and the examiner said, well, "at least"
18 includes all.

19 MR. TOERING: Okay. Sure, it includes all. But
20 there is no address identifiers, and there is -- you know,
21 again, there is no relationship back from the modified
22 combined address to the combined address. And there has to

1 be some of these relationships in here, so that the original
2 request can be addressed.

3 JUDGE OWENS: Perhaps the problem is your
4 spec says, at page 24, lines 4 to 5, "In general, an
5 address identifier may be used to identify any aspect,
6 characteristic, or attribute of a transaction and is not
7 limited to the examples included herein," which include the
8 person, company, merchant, et cetera.

9 MR. TOERING: Could you --

10 JUDGE OWENS: It's page 24, lines 4 to 5.

11 MR. TOERING: Oh, the address identifier, right,
12 "can be any characteristic or attribute of a transaction and
13 is not limited to the examples."

14 Well, yes, I understand that that is a
15 broad recitation. We still don't get to the fact that a
16 modification has occurred, because all the links in Bezos are
17 fixed. That was one of the problems with Bezos. You had an
18 intermediary link. The referral link is embedded in there.
19 Where is the modification?

20 JUDGE OWENS: Going from one to the other,
21 according to the examiner. If you can substitute the entire
22 address, then --

MR. TOERING: I understand. I mean, I understand that interpretation. I don't think that is a fair reading of what Bezos discloses. I don't think that is how one of ordinary skill in the art would understand this to mean. I don't think that is even in the examining core's ability to broadly interpret the claims.

We have stepped beyond that on multiple phases here. We have stepped beyond it in terms of the condition that is being checked. We have stepped beyond it in terms of the relationships between the combined address and the modified combined address. And now you're asking to step even further when we talk about what an address identifier could mean.

I mean, to say it could mean anything could say that it could mean going from one link to another link. That is -- and this is what the examiner is saying. He is saying this is teaching mere hyperlinking. This is not teaching mere hyperlinking. Our claim dimension is not about mere hyperlinking. It's about improvements to existing hyperlinking that was occurring in the market -- a problem that was identified and a solution towards that problem.

Before we run out of time, I would like to kind of

1 quickly address Claim 2, which talks about -- the examiner is
2 uncomfortable with this very broad recitation of a particular
3 condition, which, in our reading and interpretation of the
4 reference, is not warranted by the rejection based on this.
5 I'm not saying the claim is not broad. I'm saying the
6 reference being applied doesn't anticipate our claims.

7 But going to Claim 2, we talk about the specifics
8 of comparing the combined address against sizes. Does it
9 meet a size requirement? And then, does the modified
10 combined address also meet that size requirement? So Claim 2
11 is bringing in, you know, one of the preferred embodiments
12 into the claim to dispel this notion that a particular
13 condition is some overly broad thing that we are not
14 entitled to claim.

15 Claim 2 is being rejected on this reference
16 Presler-Marshall. And where appellants and the examiner are
17 stuck is that Presler-Marshall deals with caching systems --
18 caching Internet addresses, caching the content behind those
19 Internet addresses, so that web browsing can be more
20 efficient. If you have it local, you don't need to go get
21 it. And if you were on a telephone line back in the day
22 when we remember that, if you had it local, your browsing was
23

1 much faster.

2 Okay. The examiner is relying on a portion of
3 Presler-Marshall, and he takes it out of context and,
4 basically, misquotes the reference. The examiner states
5 that, "Presler-Marshall explicitly recites candidate objects
6 such as URLs" -- and this is in his rejection at -- or the
7 answer at page 10, about halfway down that paragraph.

8 "Presler-Marshall explicitly recites candidate
9 objects, such as URLs," and he cites a list of references in
10 Presler-Marshall.

11 The first reference that he talks about --
12 column 3, lines 30 to 35 -- recites, "an address associated
13 with a unit of information (a candidate object) which has
14 been requested, such as a URL associated with a particular
15 file." So the examiner is just reading the middle portion of
16 that phrase, where the actual language of Presler-Marshall
17 says, "An address and any unit of information can be a URL,
18 if URL corresponds to address, unit of information
19 corresponds to a particular file."

20 That's the fair reading of Presler-Marshall, not
21 that a candidate object could be a URL. That is entirely
22 inconsistent with the entirety of Presler-Marshall.

23

1 Presler-Marshall deals with these things separately. It
2 deals with addresses, and it deals with their associated
3 files or candidate objects entirely separately, draws
4 distinction clearly, and only ever refers to determining the
5 size of the candidate object -- never discusses determining
6 the size of the addresses.

7 So if you were to make the combination
8 proposed by the examiner, you would have a fair reading of
9 Presler-Marshall. You would have address -- in our claim, a
10 combined address, determining the condition of the combined
11 address, would be to pull the file pointed to by that address
12 and determining whether the size of the file exceeds some
13 condition. We are not doing that. We are looking at the
14 address itself. Okay? Does that make sense?

15 So from the straightforward point of view, the
16 combination still fails to teach the elements recited in the
17 claim. That's just a feature of the claim.

18 The next question is: Why would someone looking at
19 Bezos be motivated to go look at Presler-Marshall? Bezos is
20 talking about hyperlinking, and referral links, and those
21 kinds of things. Why would he go to a system that discusses
22 caching and determining whether the size of the cache is big
23

or small or whatever -- optimizing based on caching?

We fail to see how that nexus is drawn. We view the combination of these two references as improper. The Presler-Marshall is not analogous art in comparison to the e-commerce hyperlinking of Bezos.

The examiner's motivation to combine is to make things more efficient. Well, that's not a particularly helpful motivation to combine. That would render every single invention in the world, particularly in the computer area, obvious because, you know, that's what we do -- we try and make things more efficient. And that can't be a generic motivation to combine references in the manner.

Even then, our invention wouldn't work, if this combination was made -- because we are worried about the length of the URLs. We are not worried about the size of the content where those URLs point. So to make the modification proposed by the examiner, we wouldn't get to where we need to be.

The final thing on this that I would like to talk about is, throughout prosecution, the examiners have focused on the breadth of the claims. During an examiner interview that we had with Examiner Hewitt, the examiner said -- we

1 didn't even get a chance to really discuss the merits of the
2 claims. The examiner said, "Your claims are too broad. I
3 can find any reference that teaches determining, gathering,
4 substituting -- " you know, blah. "Your claims are
5 too broad."

6 When we got the advisory opinion, the little blurb
7 in one section of the advisory says, "Features are broad
8 enough to read on mere hyperlinking." "The features are
9 broad enough to read on mere hyperlinking." We have already
10 talked about that. They are not particularly broad enough to
11 read on mere hyperlinking.

12 In the examiner's argument, the examiner states,
13 "Arguments are not persuasive, as they fail to consider the
14 breadth of the appellants' claims." I am not aware of any
15 statute that says appellants must consider the breadth when
16 looking at scope of patentability. If our claims are so
17 broad, there should be no problem finding a reference that
18 fairly discloses, teaches, or suggests the claim's invention.

19 JUDGE OWENS: One more question. In Claim 10,
20 where is the concrete and tangible result?

21 MR. TOERING: Claim 10. The concrete and tangible
22 result in Claim 10 has to come in interpreting the one or

1 more address identifiers based on a mapping between the one
2 or more address identifiers and a portion of the combined
3 address that is represented by the one or more addresses. So
4 that interpretation, how that element of the claim interprets
5 the modified combined address to get the actual combined
6 address that is necessary to render whatever content.

7 JUDGE OWENS: All it requires is interpreting the
8 address identifiers.

9 JUDGE NAPPI: How is that tangible?

10 MR. TOERING: Well, in the language of computers,
11 interpreting means that you are looking at something and you
12 are figuring out what -- there is a transformation that is
13 occurring in that interpretation, so that the result of the
14 interpreting can be used to hit the next webpage. And that
15 is what the interpreting is.

16 JUDGE NAPPI: You haven't claimed any next step.
17 You've just done the interpretation.

18 MR. TOERING: Okay. If it's a 101 rejection that
19 needs to be levied against Claim 10, then a 101 rejection
20 needs to be levied against Claim 10. And we can resolve that
21 when prosecution is reopened.

22 But, at this stage, we are at appeal on bad art, in
23

1 our view, and we are trying to address the bad art. If the
2 Board wants to open it up on a 101, you know, that's up to
3 you, and I appreciate your insight on that.

4 JUDGE OWENS: Thank you.

5 MR. TOERING: I think I have hammered this home,
6 and I hope that I have made our points clear. I want to
7 make sure that, while I appreciate the opportunity to have
8 the oral hearing to focus on some key items, I would like
9 you to review our appeal and our reply, and we would like
10 to maintain those arguments as well, and not be construed
11 solely to the arguments presented here during the oral
12 hearing. Thank you.

13 JUDGE OWENS: Thank you.

14 Whereupon, at 10:40 a.m., the hearing in the
15 above-entitled matter was concluded.